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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,230	04/14/2006	Atsushi Yabe	4700.P0328US	7180
23474 7590 02/05/2009 FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631				
EXAMINER BAREFORD, KATHERINE A				
ART UNIT 1792		PAPER NUMBER		
MAIL DATE 02/05/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/576,230

Applicant(s)

YABE ET AL.

Examiner

Katherine A. Bareford

Art Unit

1792

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 5 and 6.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Katherine A. Bareford/
Primary Examiner, Art Unit 1792

Continuation of 11, does NOT place the application in condition for allowance because: (A) applicant's amendment to the Title removes the objection to the specification at paragraph 2 of the October 20, 2008 Final Rejection ONLY. (B) As to applicant's arguments regarding the 35 USC 103(a) rejections, the Examiner has reviewed these arguments, however, the rejection is maintained. As to the argument that Kondo provides the use of sodium hypophosphite with the formaldehyde, but the sodium hypophosphite was only used as an activator and Kondo shows almost the same plating rate for the mixture or formaldehyde alone, thus having no suggestion of advantage of combining the two materials, the Examiner disagrees. As discussed at column 13, line 65 through column 14, line 4 of Kondo, Kondo states that the sodium hypophosphite "seems to act as a reducing agent in TEA baths". Furthermore, even if it only acts as an activator the requirement of the claim of the "reducing agent" of "hypophosphite" is present. As to combining the two materials, Figure 9 clearly shows a plating rate increase when the mixture is used (also see column 14, lines 5-10). While applicant may argue that they are not concerned with plating rate, and that the references cited by the Examiner must suggest the effect of uniform plating at lower temperature (an object of the present invention), the Examiner notes that this is not what is required for a reason to use a reference. First, other reasons than that of applicant can be used to make a rejection -- "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Secondly, applicant is not claiming uniform plating at a lower temperature, and Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As to applicant's arguments that Kondo is not treating mirror surfaces, and providing roughening, the Examiner notes that the further references have been provided as to the suggest plating a mirror surface, as to Kondo requiring a roughened surface, the Examiner disagrees, for the reasons given in the paragraph bridging pages 8-9 of the Final Rejection. As to applicant's arguments that Uzoh is different from the Kondo reference, because the Kondo reference is concerned with articles or substrates having chemically roughened surfaces, and thus the two references are not combinable, the Examiner disagrees, for the reasons given on page 9 of the Final Rejection. As to applicant's argument that Maenosono discloses electrochemical deposition not electroless deposition and also would not be combinable with Kondo, and also does not have an adherent thin film layer, the Examiner disagrees with applicant's position for the reasons given in the paragraph bridging pages 9-10 of the Final Rejection. As to the discussion of '898, the applicant again argues that Kondo is limited to substrates with a chemically roughened surface, and the Examiner disagrees for the reasons given at page 10 of the Final Rejection. As to applicant's arguments as to Yoshida and Verbunt, the Examiner disagrees with applicant's position for the reasons given at page 10 of the Final Rejection. As to the argument by applicant that the Examples in the specification vs. the comparative Examples show unexpected benefits, the Examiner disagrees with applicant's position for the reasons given at the paragraph bridging pages 10-11 of the Final Rejection..